

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 101, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, both the undersigned and John Pokotylo would like to thank Examiner Tsui and Primary Examiner Paula for courtesies extended during a telephone interview on October 29, 2009 (referred to as "the telephone interview"). The telephone interview is summarized here.

Telephone Interview Summary

This statement of the substance of the Interview summarizes the issues discussed during the October 29, 2009 telephone interview. This Interview Summary is presented in the format suggested in MPEP § 713.04 by the Patent Office.

Date of Interview: October 29, 2009

Type of Interview: Telephone

Name of Participants:

- Examiners: Wilson Tsui
Cesar Paula
- For Applicant: John C. Pokotylo
Len Linardakis

A. **Exhibit(s) Shown:** None

B. **Claims discussed:** 1-7

C. **References Discussed:**

- U.S. Patent Application Publication No.
2004/0015397 ("the Barry publication")

D. **Proposed Amendments discussed:**

- The applicants' representatives proposed amendments to clarify that the ad document information and the determined relevant content come from different sources (and therefore different than both advertisements coming from an ad server as in the Barry reference).

- The applicants' representatives proposed amendments to clarify that the determined relevant content of claim 1 was one of (A) a news story, (B) a review, (C) a search query, and (D) a user group message as recited in dependent claims 2-6.

- The Examiners suggested that the claims be amended to clarify how and where from the additional content is determined.

- The Examiners acknowledged that such claim amendments would be helpful in distinguishing the claimed invention over the cited reference but noted that additional search would be required.

***E. Discussion of General Thrust
of the Principal Arguments***

- The applicants' representatives discussed the claimed invention and their understanding of the teachings of the Barry publication.

- The Examiners verified that the "ad document information" used to determine additional content was the "bid amount" from the ad.

- Various amendments and clarifications, as described above, were discussed.

F. Other Pertinent Matters Discussed: None

G. General Results/Outcome of Interview

- The Examiners acknowledged that the aforementioned proposed amendments to the claims would be helpful in distinguishing the claimed invention over the cited reference but noted that additional search would be required.

Rejections under 35 U.S.C. § 101

Claims 1-16 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, since claims 8 and 16 have been canceled, this ground of rejection is rendered moot with respect to these claims.

Next, claims independent method claims 1 and 7 have been amended to recite that each of the acts of the **computer-implemented** method is performed **by a computer system including at least one computer on a network**.

These amendments are supported, for example, by Figure 8 and page 18, line 14 through page 19, line 19 of the specification. Furthermore, claim 1 has been amended to recite that the ad document information is accepted from an ad server (supported, for example, by element 110 of Figure 1) and that the determined relevant content is from a content server (supported, for example, by element 130 of Figure 1).

In addition, independent claims 9 and 15 have been amended to remove means-plus-function elements and to include at least one processor and at least one storage device storing a computer executable code which, when executed by the at least one processor, performs a method. These amendments are supported, for example, by Figure 8 and page 18, line 14 through page 19, line 19 of the specification.

Thus, in view of the foregoing amendments, the applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 7, 9 and 15. Since claims 2-6 and 10-14 were solely rejected due to their dependence, either directly or indirectly, from claims 1 and 9, respectively, the applicants respectfully request that the Examiner reconsider and withdraw the rejection of these claims as well.

Rejections under 35 U.S.C. § 102

Claims 1, 7, 9, 15 and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0015397 ("the Barry publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Independent claims 1 and 9, as amended, are not anticipated by the Barry publication since the Barry publication does not teach (a) accepting ad document information including ad content *from an ad server* and (b) using *at least one of terms, concepts and categories from the content* of the ad document information to determine relevant content, *from a content server*, in addition to content of the ad document, *wherein the determined relevant content is one of (A) a news story, (B) a review, (C) a search query, and (D) a user group message.*

In rejecting previously presented claims 1 and 9, the Examiner cites Figure 15 and paragraph [0064] of the Barry publication, and states "whereas, an advertisement is accepted as one of the highest bidders for a particular level of content" and "whereas . . . the highest bidder for the ad document information, selecting a second highest bidder for a particular level of content." (Paper No. 20090719, page 5) During the telephone interview, Examiner Tsui clarified that the "ad document information" used to determine additional content was the "bid amount" from the ad. That is, the bid for ad 1570 of Figure 15 (characterized by the Examiner as ad document information) is used to determine

ad 1580 with the next highest bid (characterized by the Examiner as determined content in addition to content of the ad document).

In response to the Examiner's interpretation of the cited references and the language of the claims, claims 1 and 9 have been amended to clarify that the ad document information and the determined relevant content **come from different sources**. That is, claims 1 and 9, as amended, recite that the ad document information comes from an ad server while the determined relevant content comes from a content server. Furthermore, claims 1 and 9 have been amended to include the features of claim 8 (now canceled) and further clarify that the determined relevant content is one of (A) a news story, (B) a review, (C) a search query, and (D) a user group message. The amendments to claims 1 and 9 are supported by original claim 8 (now canceled), elements 110 and 130 of Figure 1, element 510 and 530 of Figure 5, page 10, lines 5-15 and page 13, lines 3-16. These amendments preclude the Examiner's interpretation since the Barry reference does not teach that the ad document information and the determined relevant content come from different sources, nor does it teach that the determined relevant content is one of (A) a news story, (B) a review, (C) a search query, and (D) a user group message.

Moreover, claims 1 and 9 have been further amended to describe **how the additional content is determined** as suggested by the Examiners during the telephone interview. Specifically, claims 1 and 9, as amended, recite that the additional relevant content is determined using **at least one of terms, concepts and categories from the content of the ad document information**. The

amendments to claims 1 and 9 are supported, for example, by page 13, lines 22-28. This further distinguishes the claimed invention from the Barry publication since the Barry publication, as characterized by the Examiner, merely uses the *bid* of the highest ad to determine the ad with the next highest bid amount.

Thus, in view of the foregoing amendments and remarks, claims 1 and 9 are not anticipated by the Barry publication.

Claims 7 and 15, as amended, are not anticipated by the cited references for at least reasons similar to those discussed above with reference to claims 1 and 9. Since claim 20 depends from claim 7, this claim is similarly not anticipated by the Barry publication.

Rejections under 35 U.S.C. § 103

Claims 2, 10 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Barry publication in further view of Edmunds.com, page 1, January 22, 2001 ("the Edmunds page"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, dependent claims 2 and 17 depend from claim 1 and claim 10 depends from claim 9. The purported teachings of the Edmunds page would not compensate for the deficiencies of the Barry publication with respect to claims 1 and 9, as amended (discussed above), regardless of the scope of purported teachings of the Edmunds page, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims

2, 10 and 17 are not rendered obvious by the cited references for at least this reason.

Second, as discussed above with respect to claim 1, the Examiner verified that the bid for ad 1570 of Figure 15 (characterized by the Examiner as ad document information) is used to determine ad 1580 with the next highest bid (characterized by the Examiner as determined content in addition to content of the ad document). By contrast, the Edmunds page is cited as showing a product review in a right hand side of the page. However, this product review is apparently just a portion of an authored article. That is, based merely on the page printout, the applicants believe that the photo caption is not determined using ad information, but is simply part of an authored article.

Third, one skilled in the art would not have modified the advertising system discussed in the Barry publication in order to use a bid amount associated with a first ad in order to determine "a product review" with the next highest bid amount. Nothing in the Barry reference, or the Edmunds page, indicates that a bid may be associated with a product review, or that anything other than ads are retrieved and displayed in the advertising spots depicted at the bottom of Figure 15 in the Barry publication. In summary, the cited references neither suggest, nor make obvious, the combination proposed by the Examiner. Consequently, these claims are not rendered obvious for at least this additional reason.

Claims 3, 8, 11, 16 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Barry publication in further view of CNET.com, page 1, December

7, 2001 ("the CNET page"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, since claims 8 and 16 have been canceled, this ground of rejection is rendered moot with respect to these claims.

Second, dependent claims 3 and 18 depend from claim 1 and claim 11 depends from claim 9. The purported teachings of the CNET page would not compensate for the deficiencies of the Barry publication with respect to claims 1 and 9, as amended (discussed above), regardless of the scope of purported teachings of the CNET page, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 3, 11 and 18 are not rendered obvious by the cited references for at least this reason.

Third, as discussed above with respect to claim 1, the Examiner verified that the bid for ad 1570 of Figure 15 (characterized by the Examiner as ad document information) is used to determine ad 1580 with the next highest bid (characterized by the Examiner as determined content in addition to content of the ad document). By contrast, the CNET page is cited as showing a service review. However, based merely on the page printout, the applicants believe that the service review is not determined using ad information.

Forth, one skilled in the art would not have been motivated to modify the advertising system discussed in the Barry publication in order to use a bid amount associated with a first ad in order to determine "a service review" with the next highest bid amount. Nothing in the Barry reference, or the CNET page,

indicates that a bid may be associated with a service review, or that anything other than ads are retrieved and displayed in the advertising spots depicted at the bottom of Figure 15 in the Barry publication. In summary, the cited references neither suggest, nor make obvious, the combination proposed by the Examiner. Consequently, these claims are not rendered obvious for at least this additional reason.

Claims 4, 12 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Barry publication in further view of MSN.com, page 1, December 7, 2000 ("the MSN page"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, dependent claims 4 and 19 depend from claim 1 and claim 12 depends from claim 9. The purported teachings of the MSN page would not compensate for the deficiencies of the Barry publication with respect to claims 1 and 9, as amended (discussed above), regardless of the scope of purported teachings of the MSN page, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 4, 12 and 19 are not rendered obvious by the cited references for at least this reason.

Second, as discussed above with respect to claim 1, the Examiner verified that the bid for ad 1570 of Figure 15 (characterized by the Examiner as ad document information) is used to determine ad 1580 with the next highest bid (characterized by the Examiner as determined content in addition to content of the ad document). By contrast, the MSN page is cited as showing "an ad" for a

service (MSN messenger) and news about the service. However, the news is apparently just a portion of an authored document. That is, based merely on the page printout, the applicants believe that the news about MSN messenger was not determined using ad information, but is simply part of an authored article.

Third, one skilled in the art would not have been motivated to modify the advertising system discussed in the Barry publication in order to use a bid amount associated with a first ad in order to determine "news about a service" with the next highest bid amount. Nothing in the Barry reference, or the MSN page, indicates that a bid may be associated with a news story, or that anything other than ads are retrieved and displayed in the advertising spots depicted at the bottom of Figure 15 in the Barry publication. In summary, the cited references neither suggest, nor make obvious, the combination proposed by the Examiner. Consequently, these claims are not rendered obvious for at least this additional reason.

Claims 5 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Barry publication in further in view of U.S. Patent No. 6,006,225 ("the Bowman patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, dependent claim 5 depends from claim 1 and claim 13 depends from claim 9. The purported teachings of the Bowman patent would not compensate for the deficiencies of the Barry publication with respect to claims 1 and 9, as amended (discussed above), regardless

of the scope of purported teachings of the Bowman patent, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 5 and 13 are not rendered obvious by the cited references for at least this reason.

Second, as discussed above with respect to claim 1, the Examiner verified that the bid for ad 1570 of Figure 15 (characterized by the Examiner as ad document information) is used to determine ad 1580 with the next highest bid (characterized by the Examiner as determined content in addition to content of the ad document). By contrast, the Bowman patent is cited as showing a search query related to a document as being "determined content". However, the Bowman patent "suggests related terms to the user to allow the user to refine a search." (Abstract of the Bowman patent) "The related terms are generated using query term correlation data" wherein "the correlation data is generated and stored in a look-up table using an off-line process which parses a query log file." (Abstract of the Bowman patent) Thus, the search query information is not generated from **ad document information** as claimed. Consequently, these claims are not rendered obvious for at least this additional reason.

Claims 6 and 14 are rejected under 35 U.S.C § 103(a) as being unpatentable over the Barry publication in further view of U.S. Patent Application Publication No. 2004/0093558A1 ("the Weaver publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, dependent claim 6 depends from claim 1 and claim 14 depends from claim 9. The purported teachings of the Weaver publication would not compensate for the deficiencies of the Barry publication with respect to claims 1 and 9, as amended (discussed above), regardless of the scope of purported teachings of the Weaver publication, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 6 and 14 are not rendered obvious by the cited references for at least this reason.

Next, as discussed above with respect to claim 1, the Examiner verified that the bid for ad 1570 of Figure 15 (characterized by the Examiner as ad document information) is used to determine ad 1580 with the next highest bid (characterized by the Examiner as determined content in addition to content of the ad document). By contrast, the Weaver publication is cited as showing a message database that stores messages from a user group. However, the Weaver publication concerns "Internet messages from an Internet discussion forum such as a standard e-mail users group, message forum or newsgroup database [which] can be transferred from the first database to a more specialized forum in a second database on a second computer." (Abstract of the Weaver publication) The message is not generated from ad document information as claimed. Consequently, these claims are not rendered obvious for at least this additional reason.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

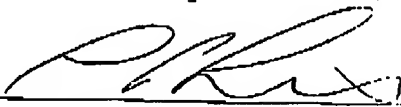
Any arguments made in this amendment pertain *only* to the specific aspects of the invention *claimed*. Any claim amendments or cancellations, and any arguments, are made *without prejudice to, or disclaimer of*, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a

rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted.

November 20, 2009

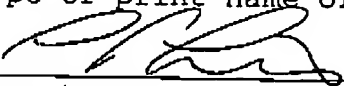

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